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EXAMINER	
RIMELL, SAMUEL G	
ART UNIT	**PAPER NUMBER**
2175	19

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/941,681	Applicant(s) MAYAUD, CHRISTIAN
	Examiner Sam Rimell	Art Unit 2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *70-91* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *70-91* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 70-86 and 88-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Schrier et al. ('599).

Claim 70: FIG. 11 of Schrier et al. discloses a system including a computer readable medium which is used to create an electronic prescription that is ultimately printed out and converted into a paper prescription. The electronic prescription includes a patient identifier (patient name), prescribed drug and drug quantifier("gentamicin 130 mg intravenously every 8 hours" and "Tylenol 250 mg" and "Penicillin 250 mg IV every four hours"). The patient includes a patient identifier data capture device (data capture field for patient name) and well as a prescribed drug and drug quantifier capture device (data capture fields for prescribed drugs and drug quantities in FIG. 11). The patient condition data capture device is the data capture field (312) permitting entry of the patient condition "pain", which indicates a current condition of the patient. When the electronic prescription system is used, it may call upon a library of prescription drugs (col. 13, line 60 through col. 14, line 5). A printer prints the completed prescription (col. 14, line 65 through col. 15, line 1).

Claim 71: FIG. 10 illustrates personal preference drug selections. In particular, the system tracks preferences for type of drug therapy and physical form of the drug. The system

tracks these selections (saves them to memory) and updates changes whenever changes are made to the selections.

Claim 72: FIG. 10 illustrates that for each condition illustrated, such as asthma, there exists a selection list which permits selection of therapy and dosing form. The condition itself may also be selected (col. 8, lines 42-46) by the user.

Claim 73: FIG. 11, section (312) illustrates the patient's history of previously prescribed drugs (For example, Tylenol) and treatment objectives (For example, Tylenol for treatment of pain).

Claim 74: Col. 8, lines 42-46 describes the input of patient conditions into the system. The patient conditions which are input become the patient condition list. This information will become part of the patient's history in section (312).

Claim 75: The electronic prescription system is a source oriented data retrieval subsystem. This subsystem may be connected to data retrieval network, such as a hospital information system or hospital database (col. 6, lines 27-32).

Claim 76: FIG. 4 illustrates a screen providing information on drug interactions. By pressing the "allergies" button, analogous information may be obtained on drug allergies.

Claim 77: The patient prescription history (312 in FIG. 11) is a current, contemporaneous record. The method by which the record is assembled is considered an intended usage of the system, and carries no patentable weight.

Claim 78: Any of the screens illustrated in Schrier et al. are user interfaces. The method steps by which the patient history record are obtained are considered an intended usage of the system, and carry no patentable weight.

Claim 79: FIG. 3 illustrates a list of drugs (232) which are classified into groups. Each group is related to a patient condition. For example, antifungals would be used for treating a fungus condition. Antidepressants would be used for treating depression. The user can select one these groups associated with patient condition and determine prescribable drugs for that condition.

Claim 80: No patentable weight is attributed to the patient's ownership of a drugs benefits plan or association with a drug benefit provider, since these features are not part of a prescription, or a physical system for creating a system. Schrier et al. does disclose a formulary (col. 13, lines 63-65) which is a subset of recommended drugs and dosages which are recommended (col. 14, lines 6-10) and displayed to the user. The "formulary preference" is set of drugs reccomended by the system (col. 14, lines 6-10) and is presented as reccomendation during the completion of the prescription. If the formulary recommendations are not used, the list of drugs recommended by the physician become a nonformulary drug list.

Claim 81: Col. 6, lines 27-32 describe the electronic prescription system as gaining access to remote data systems. No patentable weight is attributed to who actually provides the data, such as a benefits management company since this has no bearing on the physical structures of the electronic prescription system.

Claim 82: The information provided from the formulary relates to dosage recommendations for drugs. As best as can be understood, this reads as information regarding prescribability.

Claim 83: Col. 13, lines 38-52 describe the recordation of previous physician orders. Each previous physician order includes time and date, and the physician making the order (col.

13, lines 50-52). Each of these orders is a previous user access to the system. The record of these orders constitutes a log.

Claim 84: FIGS 19-22 illustrate a decision making routine that considers dosing, amount and time of termination of therapy in deciding which course of therapy is best for the patient. The recommended time for termination of therapy reads as the "expiration drug quantifier".

Claim 85: Col. 6, lines 27-32 describe the connection of the Schrier et al. system to remote hospital information systems. Data access control is established by the usage of passwords, which are the data access control specification means.

Claim 86: FIG. 3 is a screen providing a list of drugs (232) and a set of categories (234) which are associated with patient conditions. For example, "antifungals" would be associated with a fungus condition. There are at least five drugs and five categories.

Claim 88-89: Col.14, line 65 through col. 15, line 2 describe the output of a prescription from the system to a pharmacy. The pharmacy is remote storage.

Claim 90: The prescription includes dosage schedule (FIG. 11—gentamicin 130mg intravenously every 8 hours).

Claim 91: See remarks for claim 80.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al. ('599).

Claim 87: FIG. 3 is a screen providing a list of drugs (232). Although the reference does not state how many drugs are on the list, forming the list to include 50% or more of the known FDA approved drugs would have been obvious to one of ordinary skill in the art as a choice of advantageous design. The skilled artisan would readily recognize the desirability of having the list as complete as possible.

Consideration of Affidavit under 37 CFR 1.131: Accompanying the Request for Continued Examination is an affidavit submitted under 37 CFR 1.131 for the purpose of antedating the primary prior art reference to Schrier et al.

The affidavit under 37 CFR 1.131 in antedating the Schrier et al. reference for the following reasons:

1) It is not clear whether the affidavit establishes actual reduction to practice prior to Schrier et al. or conception followed by diligence towards reduction to practice.

2) The Power Point Slide Show (pages 1-19) are not dated, thus failing to support any claims for conception prior to Schrier et al.

3) The data in the Power Point Slide Show does not fully correlate to independent claim 70. In particular, the Slide Show does not illustrate subparts (i)-(iv) of part, A, and does not illustrate parts C and D.

4) If the affidavit relies is intended to show conception followed by diligence towards filing a patent application, there is no evidence in support of the diligence. In particular, there is no evidence of any activity taking place between Dec. 13, 1993 (Schrier's earliest filing date)

and December 28, 1994 (applicant's earliest filing date). There is also no evidence of diligence prior to December 13, 1993.

For the following reasons, the affidavit submitted under 37 CFR 1.131 is not effective in antedating Schrier et al., and thus the application of the Schrier et al .reference is maintained.

This office action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

Sam Rimell
Primary Examiner
Art Unit 2175